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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,280	07/21/1999	STEVEN M. UTTER	MISTY-52064	1354
7590 10/28/2005 Rosenbaum & Associates, P.C. 650 Dundee Road, Suite #380 Northbrook, IL 60062			EXAMINER KIM, CHRISTOPHER S	
			ART UNIT 3752	PAPER NUMBER

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/358,280	<b>Applicant(s)</b> UTTER, STEVEN M.	
	<b>Examiner</b> Christopher S. Kim	<b>Art Unit</b> 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,7-10,18-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,7-10,18-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The response filed August 8, 2005 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Priority***

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and/or 121 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Claims 7, 9, 10, 18-21, 23, 25, 27 and 28 have not been granted the benefit of the earlier filing date.

***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "restrictive valve

directly coupled to the inlet of the pressurizable container” recited in claims 5 and 18; and the “non-removable means for pressurizing the pressurizable container” recited in claim 24 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The amendment filed August 8, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no

amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of figures 3-8 and the accompanying description added to the specification. There has been a hiatus of disclosure between the filing of the application which issued as US Patent Number 5,535,951 ('951) and the application which issued as US Patent 5,620,140 ('140). What applicant attempts to add into the present application exists in the filing which issued as the '951 patent but has been omitted from all subsequent applications.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

6. Claims 5, 7-10, 18-21, 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5 recites "a restrictive valve directly coupled to the inlet of the pressurizable container." The specification discloses, on page 3, lines 9-10, "a flow valve 12 connected to a fluid outlet 20 of the tank, and a spray nozzle 10 connected to the flow valve 12 by a flexible or rigid tube 8." The specification further discloses, on page 3, lines 11-13, a removable cap 200 attached to the inlet to the pressurizable

container/chamber 13. The disclosure, as originally filed, fails to disclose a restrictive valve directly coupled to the inlet of the pressurizable container.

Claim 18 recites similar limitations directed to a restrictive valve directly coupled to the inlet of the pressurizable container.

Claim 24 recites "a non-removable means for pressurizing the pressurizable container." The specification disclose, on page 3, lines 11-12, a "removable cap 200" and on page 3, line 18, "pump apparatus 200 is comprised of a threaded cap 20." The specification, as originally filed, fails to disclose a non-removable means for pressurizing the pressurizable container.

### ***Claim Rejections - 35 USC § 102***

7. Claims 5, 8, 9, 18, 19, 21, 23, 24, 26 and 27 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (2,853,212).

With respect to claims 5, 8, 9, 23, 24, 26 and 27, Anderson discloses an apparatus comprising: a pressurizable container 10; means 13 for pressurizing the container; a water conduit 34 (a first conduit - portion of conduit 34 inside container 10; a second conduit - portion of conduit 34 outside container 10); a spray nozzle (column 3, lines 42); a restrictive valve (inherent in order to build up the pressure in container 10); a means for sealing 16.

With respect to claims 18, 19 and 21, Anderson discloses an apparatus comprising: a pressurizable container 10; a manual pump 13; a means for delivering fluid (spray nozzle); a means for controlling the emission of evaporative mist (valve,

which must be inherent to build up the pressure in container 10); a first conduit (portion of conduit 34 inside container 10); a second conduit (portion of conduit 34 outside container 10); a means for hands-free directing (ability for tube 34 to hang and point the nozzle downward).

Intended use recitation such as "for cooling a local area in the vicinity of a person by evaporative cooling" does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations

Functional recitation such as "said spray nozzle delivering an evaporative cooling mist of water in the vicinity of a person" has not been given patentable weight because it is narrative in form. The functional recitation merely requires the ability to so perform.

8. Claims 5, 8, 18, 19, 21, 23, 24 and 26 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Cushing (4,911,339).

With respect to claims 5, 8, 23, 24 and 26, Cushing discloses an apparatus comprising: a pressurizable container 16; means 40 for pressurizing the container; a water conduit 18, 51, 72 (a first conduit 72; a second conduit 18, 51); a spray nozzle 20; a restrictive valve 46; a means for sealing 36,70.

With respect to claims 18, 19 and 21, Cushing discloses an apparatus comprising: a pressurizable container 16; a manual pump 40; a means for delivering fluid (spray nozzle) 20; a means for controlling the emission of evaporative mist (valve) 46; a first conduit 72; a second conduit 18, 51; a means for hands-free directing (clip) 24.

***Claim Rejections - 35 USC § 103***

9. Claims 5, 8, 9, 18, 19, 21, 23, 24, 26 and 27 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (2,853,212) in view of Norman (842,689).

This rejection is on the basis that applicant believes that a valve is not inherent in Anderson.

With respect to claims 5, 8, 9, 23, 24, 26 and 27, Anderson discloses an apparatus comprising: a pressurizable container 10; means 13 for pressurizing the container; a water conduit 34 (a first conduit - portion of conduit 34 inside container 10; a second conduit - portion of conduit 34 outside container 10); a spray nozzle (column 3, lines 42); a means for sealing 16.

With respect to claims 18, 19 and 21, Anderson discloses an apparatus comprising: a pressurizable container 10; a manual pump 13; a means for delivering fluid (spray nozzle); a first conduit (portion of conduit 34 inside container 10); a second conduit (portion of conduit 34 outside container 10); a means for hands-free directing (ability for tube 34 to hang and point the nozzle downward).

Intended use recitation such as "for cooling a local area in the vicinity of a person by evaporative cooling" does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations

Functional recitation such as "said spray nozzle delivering an evaporative cooling mist of water in the vicinity of a person" has not been given patentable weight because it is narrative in form. The functional recitation merely requires the ability to so perform.



A valve must be inherent in Anderson for the device to operate, but if applicant believes that Anderson does not disclose a valve in tube 34, Norman discloses a spray nozzle and valve 8. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve of Norman to the device of Anderson to enable buildup of pressure and to control the release of water/solution.

10. Claims 10 and 28 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339).

Cushing discloses the limitations of the claimed invention with the exception of ice. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have added ice to the container of Cushing to dispense ice water.

11. Claims 7, 20 and 25 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Shurnick et al. (4,852,781).

Cushing differs from what is claimed in the means secured to the misting apparatus for attaching the misting apparatus to a person's waist. Shurnick et al. discloses a means 27 for securing a bottle to a part of a person's body (waist shown in figure 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced cage 30 of Cushing with the means 27 of Shurnick et al. to attach the device of Cushing to a runner.

12. Claims 9 and 27 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushing (4,911,339) in view of Norman (842,689).

Cushing discloses the limitations of the claimed invention with the exception of the manual piston type pump. Norman discloses a piston pump 7, 11, 12, 13, 17. It

would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the bellows pump of Cushing with the piston pump of Norman to provide faster compression.

### ***Response to Arguments***

13. Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

Regarding priority and the effective filing date of the present application, US Patent Number 5,620,140 (and subsequent patents) fail to reference the 07/698,356 and 07/376,380 applications. MPEP 201.11.III.C provides that the reference to the prior applications must identify all of the prior applications and indicate the relationship between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. The effective filing date of the present application is August 7, 1992, the filing date of the 07/927,231 application now US Patent Number 5,535,951. Cushing, having issued on March 27, 1990, qualifies as prior art.

Regarding priority for claims 7 and 25, the claims recite "means...for attaching the misting apparatus to a person's waist." US Patent Number 5,535,951 fails to disclose a means for providing such a function. Rather, it discloses shoulder straps 46. There is no disclosure for attaching the apparatus to the user's waist using the shoulder straps. The name "shoulder straps" teaches attaching the apparatus to the user's shoulders and possibly to his back.

Regarding priority for claims 9, 18-21 and 27, the claims recite a “manual piston pump” or “manual pump.” US Patent Number 5,535,951 fails to disclose a manual piston pump or a manual pump.

Regarding priority for claims 10 and 28, the claims recite “said pressurizable container contains a mixture of ice and water.” US Patent Number 5,535,951 fails to disclose the pressurizable container containing a mixture of ice and water.

Regarding priority for claim 23, the claim recites “... a first water conduit within said container...” US Patent Number 5,535,951 fails to disclose a water conduit within the container.

Claims 7, 9, 10, 18-21, 23, 25, 27 and 28 have an effective filing date of October 18, 1994 (Application Number 08/324,872).

Regarding applicant's arguments directed to the drawing objections, applicant states that “...that drawings of all earlier applications to which the current application claims priority are correctly incorporated into the present application merely by the claiming of priority to these earlier applications...” Applicant is categorically incorrect. Mere reference to priority does not constitute incorporation by reference. See MPEP 201.06(c).IV; *In re Hogan*, 559 F.2d 595, 194 USPQ 527 (CCPA 1977); *In re Schneider*, 481 F.2d 1350, 1356, 179 USPQ 46 (CCPA 1973); *In re Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

Regarding applicant's argument directed to the new matter rejection, as indicated above, under the doctrine of hiatus of disclosure, the new matter rejection is appropriate

Regarding applicant's argument that a restrictive valve is not inherent in Anderson, Anderson discloses, in column 3, lines 39-42, "To enable a pressure to be built up in the tank by reciprocation of the pump plunger and retained therein for discharging the spray solution through the tube 34 to a spray nozzle (not shown)..." A restrictive valve is inherently required for the pressure to be built up and retained in the tank.

Regarding applicant's argument that Anderson and Cushing do not teach the restrictive valve directly coupled to the inlet of the pressurizable container, in light of the new matter rejection, Anderson has been applied as best understood. The disclosure, as originally filed, fails to teach the valve directly coupled to the inlet of the pressurizable container. Additionally, only claim 5 recites the limitation "directly coupled."

Regarding applicant's argument that Anderson and Cushing do not teach a non-removable means for pressurizing the pressurizable container, in light of the new matter rejection, Anderson has been applied as best understood. The disclosure, as originally filed, fails to teach a non-removable means for pressurizing the pressurizable container. Additionally, only claim 23 recites the limitation "a non-removable means for pressurizing the pressurizable container."

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Christopher S. Kim  
Primary Examiner  
Art Unit 3752

CK